

## **REMARKS**

The above-referenced patent application has been reviewed in light of the Office Action referenced above. Reconsideration of the above-referenced patent application in view of the following remarks is respectfully requested.

Claims 1-14 are pending in the application. Claims 1-4, 6-7, 10-12, and 14 have been amended. New claims 15-32 have been added. The amendment is fully supported by the original disclosure, such as by paragraphs [0023], [0025], [0028], and [0031] of the specification, for example. No new matter has been introduced. The above amendment were, in many instances, made to clarify Assignee's claims and do not narrow the scope of the amended claims. Furthermore, in many instances, the above amendments broaden the literal scope of claims and/or claim elements. In light of this, Assignee asserts that no prosecution history estoppel should result from the above amendments.

### **Informalities in the Specification:**

The Examiner has recommended that the current title “[Optical Scanner]” be amended to be “Optical Scanner”. Assignee has followed the Examiner’s recommendation, and has amended the specification accordingly.

### **Claim Rejections:**

Claims 1 and 3-6 were rejected under 35 U.S.C. §102(b) as being anticipated by Fujioka et al., U.S. Patent No. 5,414,481 (hereinafter “Fujioka”). These rejections are respectfully traversed.

It is noted that the Examiner can establish anticipation only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. See MPEP § 2131.01. It is asserted that the Examiner has not established that Fujioka meets this requirement.

Assignee respectfully submits that Fujioka does not disclose all of the elements of independent claim 1. For example, Examiner has not established that Fujioka discloses “*a shell, comprising a light cone opening capable of receiving an imaging light of the generally vertical object.*” Specifically, the Examiner contends that “Fujioka teaches in figures 1 and 2 an optical scanner suitable for scanning a vertical object”. See page 2 of the Office Action. However, the Examiner has not cited to any portion of the specification of Fujioka or any reasoning to support the contention that in figures 1 and 2 scanning of a “*vertical object*” is what is occurring. Assignee respectfully requests that the Examiner point to exactly where the “*vertical object*” being scanned may be found in figures 1 and 2 of Fujioka. In the absence of the Examiner pointing to such a disclosure in Fujioka, Assignee requests that the rejection be withdrawn as the Examiner has failed to establish that Fujioka discloses the identical invention as is required for anticipation. See MPEP § 2131.

Further, the Examiner contends that “[i]t is common for an overhead projector such as Fujioka to be used to project (or in the reverse image) either a blackboard or whiteboard”. See page 3 of the Office Action. Assignee respectfully traverses this assertion by the Examiner, and Assignee invites the Examiner to provide a reference supporting the Examiner’s contention or an affidavit establishing facts known by the Examiner supporting the Examiner’s contention that it is common knowledge to one of

ordinary skill in the art that projectors such as Fujioka be used to image vertical objects such as blackboard or whiteboard. In the absence of such evidentiary showing by the Examiner, Assignee respectfully requests that the Examiner withdraw the rejection of claim 1, consistent with the requirements of MPEP § 2144.03.

Likewise, claims 3-6 distinguish from Fujioka on at least the same or similar basis as claim 1. Therefore, Assignee respectfully requests that Examiner's rejection of claims 3-6 be withdrawn.

Claims 2 and 7-14 were rejected under 35 USC § 103 as being unpatentable over Fujioka in view of various additional art.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. See MPEP § 2143.03. Assignee submits that claims 2 and 7-14 are not obvious due at least to the reasons set forth above with respect to the § 102 rejection.

It is noted that other bases for traversing the above rejections could be provided, but it is believed that these grounds are sufficient.

Conclusion

In light of the foregoing, reconsideration and allowance of the claims is hereby earnestly requested.

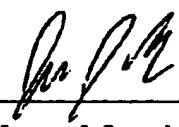
In the event an extension of time is required, please consider this a request there for, and charge the extension or any other additional fees to Deposit Account 50-3703.

Invitation for a Telephone Interview

The Examiner is invited to call the undersigned attorney, James J. Lynch, at (515)778-1633 if there remains any issue with allowance.

Respectfully submitted,  
ATTORNEY FOR ASSIGNEE

Date: December 13, 2005

  
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